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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/888,192	06/21/2001	Masao Okura	16869P-021000	8459
20350	7590	02/27/2006	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP			HAQ, NAEEM U	
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SAN FRANCISCO, CA 94111-3834			3625	

DATE MAILED: 02/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/888,192	Applicant(s) OKURA ET AL.	
	Examiner Naeem Haq	Art Unit 3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 November 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 23-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 23-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>1/13/2006</u> ; <u>1/14/2002</u> | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

This action is in response to the Applicant's amendment filed on November 29, 2005. Claims 1-22 have been cancelled. New claims 23-32 have been entered and will be considered for examination.

### ***Claim Objections***

Claim 23 is objected to because of the following informalities: This claim recites the limitation "...the priority level..." in line 7 of the claim. There is insufficient antecedent basis for this limitation in the claim. Appropriate correction is required.

Claim 24 is objected to because of the following informalities: This claim recites the limitation "...the lower level..." in line 7 of the claim. There is insufficient antecedent basis for this limitation in the claim. Appropriate correction is required.

Claim 28 is objected to because of the following informalities: This claim recites the limitation "...the order..." in line 10 of the claim. There is insufficient antecedent basis for this limitation in the claim. Appropriate correction is required.

***Specification***

The amendment filed November 29, 2005 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

Referring to claim 23 and 28: These claims recite the limitation "determining the priority level of the commodities..." This limitation is not supported by the original disclosure. These claims also recite the limitation "...in order of said determined priority level." This limitation also is not supported by the original disclosure.

Applicant is required to cancel the new matter in the reply to this Office Action.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 23-32 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Referring to claim 23 and 28: These claims recite the limitation "determining the priority level of the commodities..." This limitation does not comply with the written

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description requirement because there is no written description support for this limitation. These claims also recite the limitation "...in order of said determined priority level." This limitation does not comply with the written description requirement because there is no written description support for this limitation.

Referring to claims 24 and 29: These claims recite the limitation "...priority level...determined according to the sum of the promotion points...and the promotion points related to the lower level of processing of said commodities." This limitation does not comply with the written description requirement because there is no written description support for this limitation.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 23-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Referring to claim 23 and 28: These claims recite the terms "commodities", "promotion points", and "priority level". The Applicant's specification does not define these terms, and it is unclear to the Examiner what these terms mean.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**Claims 23-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giovannoli (US 5,758,328) (“Gio”) in view of Peirce et al. (US 6,332,126 B1) (Peirce).**

Referring to claim 23: Gio discloses an electronic commerce goods ordering method comprising: specifying conditions for ordering a desired commodity by a consumer (column 2, lines 35-65; column 5, lines 9-12, lines 18-21); searching a database for commodities having definite specifications meeting the conditions specified by the consumer (column 5, lines 37-65). Gio does not teach assigning promotion points to commodities on a basis of a distributor's sales strategy, determining a priority level of the commodities found by said searching, wherein the priority level is based on the promotion points that are assigned based on a distributor's sales strategy, or displaying to the consumer a subset of the commodities found by said searching in order of said determined priority level. However, Peirce teaches a targeted discount program that assigns promotion points to commodities on a basis of a distributor's sales strategy (col. 1, lines 33-39; col. 2, lines 18-21; col. 6, line 55 – col. 7, line 19); determines a priority level of the commodities found by said searching, wherein the priority level is based on the promotion points that are assigned based on a distributor's sales strategy (Abstract, lines 5-7; col. 11, lines 17-38); and displays to the consumer a subset of the commodities found by said searching in order of said determined priority

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level (claim 23). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Peirce into the invention of Gio. One of ordinary skill in the art would have been motivated to do so in order to provide merchants with a flexible, cost effective method to provide a large number of interested consumers with value propositions that discount the merchants products and services, and to provide consumers with a broad range of merchant offers in which they will be most interested, as taught by Peirce (col. 2, lines 18-24).

Referring to claim 24: The cited prior art teaches or suggests all the limitations of claim 23 as noted above. Furthermore, Gio teaches specifying a category, wherein said category is a complete product (column 4, lines 12-29; Figure 8: "*PROD. CATEGORY: RESISTORS*").

Referring to claim 25: The cited prior art teaches or suggests all the limitations of claim 23 as noted above. Furthermore, Gio teaches that the consumer, when ordering, is prompted to specify a category of a plurality of categories (column 4, lines 12-29). Gio does not teach that the category is a type of food. However, the Examiner notes that this limitation is not functionally involved in the steps of the recited method. Therefore this limitation is deemed to be nonfunctional descriptive material. The steps of specifying, searching, prioritizing, and displaying would be the same regardless of what type of categories were displayed to the user. The difference between the Applicants' categories and the prior art is merely subjective. Thus this nonfunctional descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir.

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1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994) also see MPEP 2106. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to use any type of categories in the invention of Gio because such information does not functionally relate to the steps of the claimed method and because the subjective interpretation of information does not patentably distinguish the claimed invention.

Referring to claims 26 and 27: The cited prior art teaches or suggests all the limitations of claim 23 as noted above. The cited prior art does not teach a restriction on diet, or a price constraint. However, the Examiner notes that these limitations are not functionally involved in the steps of the recited method. Therefore these limitations are deemed to be nonfunctional descriptive material. The steps of specifying, searching, prioritizing, and displaying would be the same regardless of what type of information were displayed to the user. The difference between the Applicants' displays and the prior art is merely subjective. Thus this nonfunctional descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994) also see MPEP 2106. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to display any type of information to the user in the invention of Gio because such information does not functionally relate to the steps of the claimed method and because the subjective interpretation of information does not patentably distinguish the claimed invention.



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Referring to claim 28: Claim 28 is rejected under the same rationale as set forth above in claim 23.

Referring to claim 29: Claim 29 is rejected under the same rationale as set forth above in claim 24.

Referring to claim 30: Claim 30 is rejected under the same rationale as set forth above in claim 25.

Referring to claims 31 and 32: Claims 31 and 32 are rejected under the same rationale as set forth above in claim 26 and 27.

### ***Response to Arguments***

Applicant's argument has been fully considered but they are not persuasive. The Applicant has argued that claims 25-27 do not recite non-functional descriptive material. The Examiner respectfully disagrees. The limitations and claims 25-27 are not functionally involved in the steps of the recited method because they do not affect the method steps in anyway. For this reason, the Examiner maintains the art rejection.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naeem Haq whose telephone number is (571)-272-6758. The examiner can normally be reached on M-F 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn W. Coggins can be reached on (571)-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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**Naeem Haq**, Patent Examiner

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February 17, 2006



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